

26. The method of claim 25 wherein:

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said DNA includes at least three of said 2'-deoxynucleotides linked together in a sequence:

each PNA includes at least two peptide nucleic acid subunits; and

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said 2'-deoxynucleotides are joined via phosphodiester, phosphorothioate or
phosphorodithioate linkages.--

REMARKS

Claims 13-16, 19, 20, and 24-26 are pending in this patent application. Added claims 24-26 find support, for example, in original claims 8-10 and 20. The amendment to the specification finds support, for example, at page 9 of application Serial No. 08/088,658, filed July 2, 1993, the disclosure of which has been incorporated by reference. (*see, e.g.*, present specification at page 1, lines 9-18).

The Examiner did not initial the entries for references AO, AP, AT or BO on the form PTO-1449 filed on September 23, 1997. Enclosed for the Examiner's consideration is a replacement copy of form PTO-1449.

The disclosure stands rejected due to a number of perceived informalities that are believed to be addressed by the foregoing amendments. Although the Office Action asserts that the first two sentences of the specification must be merged, Applicants are aware of no legal requirement for such merger, which would create a single confusing, run-on sentence.

Claims 19, 20, and 22 stand rejected under 35 U.S.C. § 112, second paragraph, for alleged indefiniteness. The amendments to claims 19 and 20, together with the cancellation of claim 20 in favor of claims 24-26, are believed to address the Examiner's concerns.

Claims 13-16, 19, and 20 stand rejected under 35 U.S.C. § 112, first paragraph, for alleged lack of enablement. Applicants respectfully request reconsideration of this rejection, as there is no reason of record to believe that those skilled in the art would not be able to practice the claimed inventions.

The first paragraph of § 112 requires that the disclosure of a patent application be such that persons skilled in the art, having read the patent application, would be able to practice the inventions described by the claims. *In re Wands*, 8 U.S.P.Q.2d 1400 (Fed. Cir. 1988). There is no legal requirement that this be done in any particular manner. An enabling disclosure can be provided by the use of illustrative examples or simply by broad terminology. *In re Marzocchi*, 169 U.S.P.Q. 367 (C.C.P.A. 1971).

When rejecting a claim under the enablement requirement of § 112, the Patent Office bears the "initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by that claim is not adequately enabled by the description of the invention provided in the specification." *In re Wright*, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993). To object to a specification on the grounds that the disclosure is not enabling with respect to the scope of a claim sought to be patented, the Examiner must provide evidence or technical reasoning substantiating those doubts. *Id.*; and MPEP Section 2164.04. Without a reason to doubt the truth of

the statements made in the patent application, the application must be considered enabling. *In re Wright*, 27 U.S.P.Q.2d at 1513; *In re Marzocchi*, 169 U.S.P.Q. at 369.

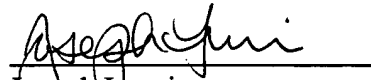
Significantly, the Office Action fails to provide any facts indicating a reason to doubt that Applicants' disclosure would enable those skilled in the art to practice the claimed inventions. Although the Office Action cites the Rojanasakul reference for the proposition that antisense treatment can involve "problems" (Office action at page 5), there is no reason of record to believe that these "problems" will be so great that persons skilled in the art will not be able to practice the claimed methods and obtain some measurable result. Indeed, "problems" of one kind or another are frequently encountered in even the most successful of endeavors. Accordingly, the mere possibility that "problems" might be encountered in practicing the claimed inventions falls far short of demonstrating that those skilled in the art would be unable to practice such inventions to at least some measurable extent. Reconsideration and withdrawal of the rejection under § 112, first paragraph, is therefore requested.

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PATENT

Applicant submits that the claims presently before the Examiner patentably define the invention over the applied art and are in condition for ready allowance. An early Office Action to that effect is, therefore, earnestly solicited.

Respectfully submitted,



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